

**RECEIVED**  
**CENTRAL FAX CENTER**

AUG 20 2004

**ARNOLD & PORTER LLP**

202.942.5000  
 202.942.5999 Fax

555 Twelfth Street, NW  
 Washington, DC 20004-1206

## Fax Transmittal

August 20, 2004

RECIPIENT NAME(S)	RECIPIENT FAX NUMBER(S)	RECIPIENT TELEPHONE NUMBER(S)
US Patent and Trademark Office Board of Patent Appeals and Interferences	(703) 872-9306 (703) 308-6200	(703) 305-4673
SENDER	SENDER'S TELEPHONE NUMBER	SENDER'S ROOM NUMBER
Thomas E. Holsten	(202) 942-5085	981
CLIENT/MATTER NUMBER	TIMEKEEPER NUMBER	NUMBER OF PAGE(S)
16517.001	5230	We are transmitting 32 page(s). (including this cover sheet)
TRANSMISSION DEADLINE (DATE & TIME)	ALTERNATE TELEPHONE NUMBER (OPTIONAL)	
This document must be transmitted no later than: August 20, 2004/ASAP	Alternate telephone number at which the sender can be reached if there are difficulties with this fax: (202) 942-5159	
If you experience difficulty receiving this fax transmission, please contact the operator at 202.942.5837.		
<b>MESSAGE</b>		

Re: Appeal Nos. 2003-1072, 2003-1073, 2003-1074, 2003-1666, 2003-1939, 2004-1034, 2004-1272,  
 2004-1273, 2004-1275, 2004-1406, 2004-1480, 2004-1725, 2004-1773 and  
 Application No. 09/267,199 (BHAT *et al.*) filed March 12, 1999 (Conf. No. 6701)  
 Atty. Dkt. Nos.: 16517.323, 16517.326, 16517.324, 16517.128, 16517.277,  
 16517.314, 16517.032, 16517.285, 16517.276, 16517.272,  
 16517.281, 16517.231, 16517.142 and 16517.233

See the attached. Please acknowledge receipt via return facsimile.

### PRIVILEGED AND CONFIDENTIAL

Information intended only for the use of the addressee named above. If the reader of this message is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, please note that any dissemination, distribution or copying of this communication is strictly prohibited. Anyone who receives this communication in error should notify us immediately by telephone and return the original message to us at the above address via the U.S. Mail.

**BEST AVAILABLE COPY**

---

**ARNOLD & PORTER LLP**

---

Thomas E. Holsten  
Thomas\_Holsten@aporter.com

202.942.5085  
202.942.5999 Fax

555 Twelfth Street, NW  
Washington, DC 20004-1206

August 20, 2004

VIA FACSIMILE

Board of Patent Appeals and Interferences  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Re: Requests for Suspension of Appeal

Dear Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office is a Request for Suspension of Appeal for each of the following applications:

1. Appeal No.: Not Yet Assigned/Conf. No. 6701  
Serial No. 09/267,199, filed March 12, 1999  
Applicants: Barkur G. BHAT *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with the Tocopherol Pathway  
Attorney Docket No.: 16517.233
2. Appeal No.: 2003-1072  
Serial No. 09/333,534, filed June 14, 1999  
Applicants: Timothy W. CONNER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.323
3. Appeal No.: 2003-1073  
Serial No. 09/540,234, filed April 3, 2000  
Applicants: Timothy W. CONNER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.326
4. Appeal No.: 2003-1074  
Serial No. 09/552,086, filed April 19, 2000  
Applicants: Robert E. BUEHLER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.324
5. Appeal No.: 2003-1666  
Serial No. 09/521,640, filed March 10, 2000  
Applicants: Joseph R. BYRUM *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.128

Washington, DC   New York   London   Brussels   Los Angeles   Century City   Northern Virginia   Denver

---

## ARNOLD & PORTER LLP

---

Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office  
August 20, 2004  
Page 2

6. Appeal No.: 2003-1939  
Serial No. 09/333,535, filed June 14, 1999  
Applicants: Joseph R. BYRUM *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.277
7. Appeal No.: 2004-1034  
Serial No. 09/666,355, filed September 20, 2000  
Applicants: Karen L. FINCHER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.314
8. Appeal No.: 2004-1272  
Serial No. 09/371,146, filed August 9, 1999  
Applicants: Nordine CHEIKH *et al.*  
Title: Annotated Plant Genes  
Attorney Docket No.: 16517.032
9. Appeal No.: 2004-1273  
Serial No. 09/637,086, filed August 11, 2000  
Applicants: Karen L. FINCHER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.285
10. Appeal No.: 2004-1275  
Serial No. 09/540,235, filed April 3, 2000  
Applicants: Dane K. FISHER *et al.*  
Title: Nucleic Acid Sequences from Cyanidium Caldarium and Uses Thereof  
Attorney Docket No.: 16517.276
11. Appeal No.: 2004-1406  
Serial No. 09/553,094, filed April 18, 2000  
Applicants: Scott E. ANDERSEN *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.272

---

## ARNOLD & PORTER LLP

---

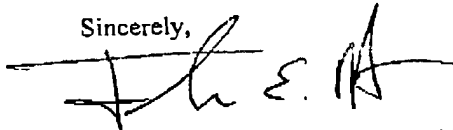
Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office  
August 20, 2004  
Page 3

12. Appeal No. 2004-1480  
Serial No. 09/732,627, filed December 8, 2000  
Applicants: Karen L. FINCHER *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.281
13. Appeal No.: 2004-1725  
Serial No. 09/233,218, filed January 20, 1999  
Applicants: Claire A. CAJACOB *et al.*  
Title: Nucleic Acid Molecules and Other Molecules Associated with the Tetrapyrrole  
Pathway  
Attorney Docket No.: 16517.231
14. Appeal No.: 2004-1773  
Serial No. 09/421,106, filed October 15, 1999  
Applicants: Joseph R. BYRUM  
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants  
Attorney Docket No.: 16517.142

It is respectfully requested that acknowledgement of receipt of these waivers be sent via return facsimile to the undersigned at 202-942-5999.

In the event that extensions of time are necessary to prevent abandonment of these patent applications, then such extensions of time are hereby petitioned. Appellants do not believe any fees are due in conjunction with these filings. However, if any fees are required in the present applications, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.001.

Sincerely,



David R. Marsh (Reg. No. 41,408)  
Thomas E. Holsten (Reg. No. 46,098)

Enclosures

RECEIVED  
CENTRAL FAX CENTERIN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

AUG 20 2004

In re application of:

Claire A. CAJACOB *et al.*

Appln. No.: 09/233,218

Filed: January 20, 1999

Title: Nucleic Acid Molecules and Other Molecules Associated with the Tetrapyrrole Pathway

Art Unit: 1637  
Examiner: Young J. Kim  
Atty. Dkt. No.: 16517.231  
Appeal No.: 2004-1725

## Request for Suspension of Appeal

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the Board of Patent Appeals and Interferences ("Board") suspend action in the above-captioned appeal. The issues presented in the appeal involve the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112 and the sufficiency of the written description of these sequences. An appeal involving the utility of partial nucleic acid molecules is currently pending before the United States Court of Appeals for the Federal Circuit ("Federal Circuit"). The sufficiency of the written description has been decided by the Board under similar circumstances as the present appeal.<sup>1</sup>

On April 28, 2003 Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on June 27, 2003 and waived oral hearing on July 22, 2004.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in *In re Fisher* (U.S. Appln No. 09/619,643, B.P.A.I. Appeal

<sup>1</sup> Rejections for the lack of sufficiency of the written description, have repeatedly been reversed by the Board in similar cases. See, Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

I hereby certify that the foregoing Request for Suspension of Appeal is being facsimile transmitted to the attention of the Board of Patent Appeals and Interferences, via facsimile number (703) 308-6200, and to the U.S. Patent and Trademark Office central facsimile number (703) 872-9306.

August 20, 2004

Claire A. CAJACOB *et al.*  
Ser. No. 09/233,218  
Appeal No. 2004-1725  
Page 2

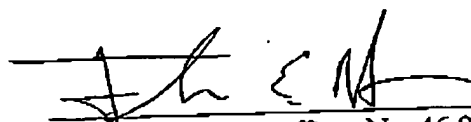
No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112.<sup>2</sup>

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in the appeal, is sound practice. *See e.g.*, M.P.E.P. §1213, 8<sup>th</sup> Edition, Revision No. 2, at page 1200-31.

For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,

Date: August 20, 2004

  
Thomas E. Holsten (Reg. No. 46,098)  
David R. Marsh (Reg. No. 41,408)

Of Counsel  
Lawrence M. Lavin, Jr. (Reg. No. 30,768)  
Thomas E. Kelley (Reg. No. 29,938)  
Monsanto Company

ARNOLD & PORTER LLP  
555 Twelfth Street, NW  
Washington, DC 20004-2402  
(202) 942-5000 telephone  
(202) 942-5999 facsimile

<sup>2</sup> The Board has upheld Examiners' utility rejections in similar appeals. *See, e.g.* Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**